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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/030,098 | 05/03/2002 | Shogo Ishioka | 011713 | 5721 |

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| EXAMINER | |
|---|---|
| ROSEN, NICHOLAS D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3625 | |

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/030,098 | ISHIOKA ET AL. | |
| | Examiner | Art Unit | |
| | Nicholas D. Rosen | 3625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *16 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 May 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.



5.0.0

## DETAILED ACTION

Claims 1-11 have been examined.

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on May 17, 2000 (Application 2000-145297). It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b), or at least no such copy has been found in the file, although there is a copy of the PCT Application PCT/JP01/04099.

### *Response to Traversal of Official Notice*

Applicant has respectfully demanded that Examiner provide evidence to support his takings of official notice. Specifically:

In rejecting claims 3 and 6, Examiner took official notice that it is well known to designate a deadline for finding or purchasing a desired product. This is supported by Gerstner, "Temporal Price Dispersion" (Abstract only), in particular the paragraph beginning "The third essay (chapter 4)."

In rejecting claims 8 and 10, Examiner took official notice that computer readable media storing programs to cause computers to carry out their intended functions are well known. This supported by the Microsoft Press Computer Dictionary, definitions of program and program file (page 384), and definitions of disc and disk (page 150).

In addition, Applicant writes, "The Examiner rejects these dependent claims on the basis of Official Notice directed towards the obviousness of designating a level of investigation, deadline for investigation, and the use of a computer-readable medium," but Examiner did not in fact take official notice of the obviousness of designating a level of investigation, and is therefore not obliged to provide evidence supporting that.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-3**

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) in view of the article

abstract, "Pat Ludwick: Kicking the Tires for Used-Car Buyers." Hulls discloses an information service method for providing information via a network including a first information-processing apparatus and a second information-processing apparatus (Figure 1), said information service method comprising steps of: inputting identification information of a product for purchase from a user of said network to said first information-processing apparatus (Figures 3 and 4; paragraphs 29 and 30); inputting an order for a surrogate investigation of said product from said user to said first information-processing apparatus (Figure 5, especially fields 26, 27, and 28; paragraph 31); and transmitting identification information of said user, identification information of said product, and an instruction on said surrogate instruction from said first information-processing apparatus to said second information-processing apparatus (Figures 8, 10, and 13; paragraphs 32, 33, and 39-43); Hulls is not fully explicit about storing said user identification information and said product identification information in said second information-processing apparatus, but does disclose storing information at a central site (paragraph 25), and from Hulls's disclosure of making information available to an agent, the information would inherently have to be stored on the second information-processing apparatus, whether one reads "second information-processing apparatus" as referring to the Site Computer System in Figure 1 of Hulls, in which case the information would have to be stored to be made available to agents as they log on (paragraph 25, and paragraphs 38-42), or as referring to the Agent's Computer/Modem in Figure 1 of Hulls, in which case the information would have to be stored, at least temporarily, at the agent's computer to be displayed. Hulls discloses calling said

product identification information from said second information-processing apparatus to identify said product so as to conduct an investigation of said identified product by an appointed investigation agent (paragraphs 38-42; Figures 9, 10, and 13); and providing information obtained from said investigation to said user identified on the basis of said user identification information (paragraphs 43, 44, and 45; Figures 16, 16B, 17, 20, and 21). Hulls does not disclose that the investigation is a physical investigation, but it is well-known conduct physical investigations, as taught by the "Pat Ludwick" article. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to conduct a physical investigation, for the obvious advantage of providing information regarding the physical condition of a used car or other physical object being considered for purchase.

As per claim 2, Hulls discloses publishing information for designating a store and information about products dealt by said store on said network including said first and second information-processing apparatuses (paragraphs 34-36; Figures 1, 23, 24, 25), wherein said user (the buyer) identifies a product for purchase among said published products (paragraphs 45 and 46; Figures 5, and 6).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) and the "Pat Ludwick" article as applied to claim 1 or 2 above, and further in view of official notice. Hulls does not disclose designating the level of an investigation or a deadline for the answer of said investigation, but official notice is taken that it is well known to designate a deadline for finding or purchasing a desired product. Hence, it would have been obvious to one of

ordinary skill in the art of electronic commerce at the time of applicant's invention to designate the level of an investigation or a deadline for the answer of said investigation, for the obvious advantage of attempting to obtain a product or information about a product before the product is needed, e.g., for a particular project, or as a birthday present, etc.

**Claims 4-6**

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) in view of the article abstract, "Pat Ludwick: Kicking the Tires for Used-Car Buyers." As per claim 4, Hulls discloses an information service system for providing information via a network, said information-processing service system comprising: a first information-processing apparatus and a second information-processing apparatus (Figure 1), said first information-processing system including: means for acquiring identification information of a product purchase and an order of a surrogate investigation of said product (Figures 3, 4, and 5, especially fields 26, 27, and 28 of Figure 5; paragraphs 29, 30, and 31), and means for transmitting identification information of said user, identification of said product, and an instruction of said surrogate investigation, to said second information-processing apparatus (Figure 1; paragraphs 23-25); and said second information-processing apparatus including: means for storing said user identification information and said product identification information with a certain association therebetween (paragraphs 25 and 38-45), and means for providing information about a result of an investigation by an appointed investigation agent to said user, said investigation being

related to said product identified on the basis of said information stored in said storing means (Figure 1, paragraphs 23-26, and 38-48). Hulls does not disclose that the investigation is a physical investigation, but it is well-known conduct physical investigations, and provide information about the results, as taught by the "Pat Ludwick" article. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to conduct a physical investigation, for the obvious advantage of providing information regarding the physical condition of a used car or other physical object being considered for purchase.

As per claim 5, Hulls discloses acquiring means operable to acquire the identification information of a product for purchase and the order in parallel with publishing information for designating a store and information about products dealt by said store on said network to provide the products to the buyer/user (paragraphs 34-36; Figures 1, 23, 24, 25).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) and the "Pat Ludwick" article as applied to claim 4 or 5 above, and further in view of official notice. Hulls does not disclose that the acquiring means is operable to acquire designated information about the level of an investigation or a deadline for the answer of said investigation, but official notice is taken that it is well known to designate a deadline for finding or purchasing a desired product. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to acquire designated information about the level of an investigation or a deadline for the answer of said

investigation, for the obvious advantage of attempting to obtain a product or information about a product before the product is needed, e.g., for a particular project, or as a birthday present, etc.

**Claims 7 and 8**

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) in view of the article abstract, "Pat Ludwick: Kicking the Tires for Used-Car Buyers." Hulls discloses a server apparatus (the Site Computer System shown in Figure 1) to be connected to an information-processing terminal (the Buyer's Computer/Modem) via a network, said information-processing terminal including: means for acquiring identification information of a product for purchase and an order of a surrogate investigation of said product from a user of said network (Figures 1, 3, 4, and 5, especially fields 26, 27, and 28 of Figure 5; paragraphs 29, 30, and 31), and means for transmitting identification information of said user, identification of said product, and an instruction of said surrogate investigation, to said server system (Figure 1; paragraphs 23-25); and wherein said server apparatus comprises: means for storing said user identification information and said product identification information with a certain association therebetween (paragraphs 25 and 38-45), and means for providing information about a result of an investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means (Figure 1, paragraphs 23-26, and 38-48). Hulls does not disclose that the investigation is a physical investigation, but it is well-known conduct physical

investigations, and provide information about the results, as taught by the "Pat Ludwick" article. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to conduct a physical investigation, for the obvious advantage of providing information regarding the physical condition of a used car or other physical object being considered for purchase.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) and "Pat Ludwick: Kicking the Tires for Used-Car Buyers," as applied to claim 7 above, and further in view of official notice. Hulls does not expressly disclose that a computer readable medium storing a program to be read in and executed on a computer is used to implement the server apparatus. However, official notice is taken that computer readable media storing programs to cause computers to carry out their intended functions are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use such a computer readable medium storing a program, for the obvious advantage of causing the server apparatus to carry out its disclosed functions.

**Claims 9 and 10**

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) in view of the article abstract, "Pat Ludwick: Kicking the Tires for Used-Car Buyers." Hulls discloses an information-processing terminal (the Buyer's Computer/Modem shown in Figure 1) to be connected to a server apparatus (the Site Computer System shown in Figure 1) via a network, said

server apparatus including: means for storing identification information of a user of said network and identification information of a product for purchase with a certain association therebetween (paragraphs 25 and 38-45), and means for providing information about a result of an investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means (Figure 1, paragraphs 23-26, and 38-48); and wherein said information-processing terminal comprises: means for acquiring identification information of a product for purchase and an order of a surrogate investigation of said product from said user of said network (Figures 1, 3, 4, and 5, especially fields 26, 27, and 28 of Figure 5; paragraphs 29, 30, and 31), and means for transmitting identification information of said user, identification of said product, and an instruction on said surrogate investigation, to said server apparatus (Figure 1; paragraphs 23-25). Hulls does not disclose that the investigation is a physical investigation, but it is well-known conduct physical investigations, and provide information about the results, as taught by the "Pat Ludwick" article. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to conduct a physical investigation, for the obvious advantage of providing information regarding the physical condition of a used car or other physical object being considered for purchase.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) and "Pat Ludwick: Kicking the Tires for Used-Car Buyers," as applied to claim 9 above, and further in view of official

notice. Hulls does not expressly disclose that a computer readable medium storing a program to be read in and executed on a computer is used to implement the server apparatus. However, official notice is taken that computer readable media storing programs to cause computers to carry out their intended functions are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use such a computer readable medium storing a program, for the obvious advantage of causing the server apparatus to carry out its disclosed functions.

**Claim 11**

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) in view of the article abstract, "Pat Ludwick: Kicking the Tires for Used-Car Buyers." Hulls discloses an information service method comprising the steps of: acquiring identification information of an applicant for purchase and of a product for purchase designated by said applicant via a network (Figures 1, 3 and 4; paragraphs 29 and 30); storing said acquired identification information (paragraph 25; see also Hulls's description of making the information available to an agent; Figures 8, 10, and 13; paragraphs 32, 33, and 39-43); acquiring an order for a surrogate investigation of said product from said applicant (Figure 1; Figure 5, especially fields 26, 27, and 28; paragraph 31); and providing information obtained from an investigation of said product by an appointed investigation agent, to said applicant on a basis of the stored identification information via the network (paragraphs 43, 44, and 45; Figures 1, 16, 16B, 17, 20, and 21). Hulls does not

disclose that the investigation is a physical investigation, but it is well-known conduct physical investigations, and provide information about the results, as taught by the "Pat Ludwick" article. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to conduct a physical investigation, for the obvious advantage of providing information regarding the physical condition of a used car or other physical object being considered for purchase.

### *Response to Arguments*

Applicant's arguments filed May 16, 2005, have been fully considered but they are not persuasive. Applicant has overcome the rejections of various claims under 35 U.S.C. 102, as anticipated by Hulls, by reciting a physical investigation, but this is held to be obvious based on a secondary reference, the "Pat Ludwick" article. Applicant has also traversed Examiner's takings of official notice, in response to which Examiner has made prior art of record to support the well-known facts of which official notice was taken. Examiner did not, however, take official notice that it is well known to designate a level of investigation, and is not obliged to provide prior art proving that to be well-known. Claims 3 and 6 are written in the alternative, "level of said investigation or a deadline for the answer of said investigation," and would therefore not be patentable on that ground even if, hypothetically, Applicant were proven to be the inventor of designating a level of an investigation, with no prior art teaching anything remotely analogous.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. White (U.S. Patent Application Publication 2005/0091124) discloses a product purchase decision making and information device (note paragraph 23 for reliance on the results of physical product testing).

Gerstner ("Temporal Price Dispersion") discloses consumers insisting on buying a particular gift item before Christmas. The Microsoft Press Computer Dictionary, Third Edition, pages 150 and 384, discloses program files as disk files, and disks as computer readable media. The anonymous article, "Global Technovations Has Record Month for OSA-II Orders," discloses individuals from other cities contracting with an appraiser to inspect the car (see especially two paragraphs beginning from "Additionally, the Company announced").

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen

**NICHOLAS D. ROSEN**
**PRIMARY EXAMINER**

July 15, 2005